

REMARKS**A. The Election/Restriction Requirement**

The May 21, 2004 Office Action sets forth the following restriction of Applicants' claims under 35 U.S.C. §121:

Group 1: Claims 2-18 and 20-27, drawn to compositions comprising a non-covalent association complex comprising a positively charged backbone, classified for example in class 514, subclass 1.

Group 2: Claims 28-37, drawn to methods of delivering a biological agent to a cell, classified for example in class 514, subclass 44.

Group 3: Claims 38 and 39, drawn to a kit and a method of preparing a pharmaceutical composition, classified for example in class 514, subclass 2.

The Examiner also requires election of a species recited in claim 1 and enumerated 24 combinations of group members (which is a subset of the total number of combinations of group members) based on the Markush group of claim 1. Moreover, the Examiner requires the election of a therapeutic or cosmeceutical agent from the specification.

C. Applicants' Response to the Election Restriction Requirement

In response to the election/restriction requirement, Applicants hereby elect to prosecute Group 1, species ii/v, where the biological agent is botulinum toxin (BOTOX). This election corresponds to claims 1-4 and 10-18, which are readable on the elected invention. The election is made with traverse. Applicants hereby reserve their right to file co-pending divisional applications directed to the non-elected subject matter.

Applicants respectfully traverse this election/restriction requirement on the grounds that the search and examination of the entire application can be made without serious burden to the Examiner. The MPEP states “If the search and examination of an entire application can be made **without serious burden**, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” See MPEP §803 (emphasis added). Applicants respectfully submit that a search for the subject matter of the three groups set forth in the Office Action would pose no “serious burden” because in performing the search for one group (e.g., the compositions in Group 1), the Examiner would likely find references for the other groups (e.g., methods for delivery and/or kits), to the extent that any such references exist. Thus, Applicants believe that there would be no serious burden on the Examiner.

In any event, in addition to electing a Group and a species, as required, Applicants also take this opportunity to address the Examiner’s assertion that claim 1 is “indefinite.” (*see* Office Action, page 6, line 21 to page 7, line 14). Applicants respectfully disagree with Examiner’s characterization of Applicants’ claim 1.

The Examiner appears to object to the recitation of a “first negatively-charged backbone,” a “second negatively-charged backbone” and a “third negatively charged backbone” and states that with respect to a third negatively charged backbone, “it is unclear whether or not this requires that there must also be a first and a second negatively charged backbone” (Office Action, bridging paragraph between pages 6 and 7).

Applicants respectfully maintain that the use of the words “first”, “second” and “third” simply enumerate different possible elements from which a practitioner can choose when practicing Applicants’ invention. The use of such words implies neither the number of elements

which must be used in practicing the invention (which is set forth elsewhere in the claim), nor any order in combining elements of the claim.

Applicants note that the Examiner himself correctly interpreted claim 1 when he enumerated some of the possible combinations of group members, as shown on page 7, lines 12-14 of the Office Action. For example, the Examiner correctly stated the combination ii/v (i.e., “a second negatively charged backbone...” and “a third negatively charged backbone...”) was one possible combinations that could arise from claim 1.

Applicants believe that this paper is fully responsive to the election/restriction requirement set forth for the application.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

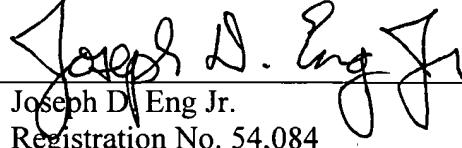
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this paper to Deposit Account No. 13-4500, Order No. 4649-4006. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4649-4006. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,
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Dated: June 21, 2004

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